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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,269	03/12/2004	Massimo Rossi	BUG5-36494	8666
116 7590 01/02/2008 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			EXAMINER YOON, TAE H	
			ART UNIT 1796	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/799,269	Applicant(s) ROSSI ET AL.	
	Examiner Tae H. Yoon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recites "23.degree.C." in claim 14 is confusing and indefinite since a claim cannot have a period {.} other than at the end of a claim. It should be "23 degree C" instead.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 - 23 are rejected under 35 U.S.C. 103(a) as obvious over Porter et al (US 2003/0036036 A1) and Jada (US 5,852,068), and in view of Jacob et al (US 6,342,187) and Miyahara et al (US 5,106,301).

Jada teaches the instant composition comprising a base polymer and a catalyst polymer at col. 3, lines 22-32 and in examples 1-3 wherein a mixture of polydimethylsiloxane having terminal vinyl groups in said each component and viscosities (1 cP = 1 mPa.s) thereof and silica are taught. Extending fillers in claim 10

would be optional when combined with claim 9 wherein a choice of the extending fillers and reinforcing fillers is claimed. The instantly recited "comprising" permits the presence of other component, and also, said polydimethylsiloxane having the lowest viscosity such as 1000 mPa.s would meet the instant silicon oil of claim 6. Said examples teach employing inorganic filler in said each component and said inorganic filler is taught at col. 5, lines 9-17 wherein the instant radio-opacifying fillers (such as zirconium silicate, zirconium oxide and zinc oxide) are seen. Choosing said radio-opacifying fillers for said examples would be anticipation since choice is very limited. See *In re Arkley*, 455 f2d 586, 172 USPQ 524 (CCPA 1972); *In re Petering*, 301 F2d 676, 133 USPQ 275 (CCPA 1962). Also, polydimethylsiloxane containing hydrosily group, and chloroplatinic acid of example 1 meet the instant reticulating agent and catalyst, respectively.

The instant invention further recites aseptic material and other radio-opacifying fillers over Jada. However, sterilization of devices and materials used in dental and medical practices by various methods such as X-ray in order to prevent infections is well known practice as taught by Jacob et al, col. 2. Miyahara et al teach various radio-opacifying fillers at col. 3, line 58 to col. 4, line 9.

The instant invention now recites a method of impression taking during immediate loading technique over Jada, Jacob et al and Miyahara et al who, in combination, teach the instant impression taking materials. However, said method of impression taking during immediate loading technique is well known practice in the art

as taught by Porter et al, abstract and pp. [0037]-[0038]. A patient's mouth under immediate loading technique inherently has an open wound.

It would have been obvious to one skilled in the art to sterilize said polydimethylsiloxane dental impression material containing radio-opacifying fillers of Jada with X-ray of Jacob et al before use since sterilization of devices and materials used in dental and medical practices by various methods such as X-ray in order to prevent any infection to patients is well known practice, and further to utilize other radio-opacifying fillers of Miyahara et al in Jada thereof since Jada teaching employing radio-opacifying fillers, and further to utilize said sterilized polydimethylsiloxane dental impression material containing radio-opacifying fillers in taking an impression of Porter et al since Porter et al teach taking an impression after implanting and since use of art well known impression taking material such as polydimethylsiloxane with known additives and sterilization would be a *prima facie* obviousness absent showing otherwise.

Claims 14-24 are rejected under 35 U.S.C. 103(a) as obvious over Porter et al (US 2003/0036036 A1) and Jada (US 5,852,068), and in view of Jacob et al (US 6,342,187) and Miyahara et al (US 5,106,301), and further in view of Smith (US 4,007,153) or Fiedler (US 5,830,951).

The invention further recites employing extending fillers having a BET surface area below 50 m²/g and silica over fillers of Porter et al and Jada (col. 5, lines 9-21 wherein calcium carbonate is taught) thereof Silicic acid taught at col. 5, line 14 of Jada is silica. Lower the BET surface area, the lower the porosity, and filler with such

property would have a low oil absorption. Smith teaches such calcium carbonate at col. 5, lines 46-57 and Fiedler teaches that the lower surface area of the fillers would improve flowing of a low viscosity impression materials at col. 9, lines 5-10. Fiedler teaches the use of mixed fillers in examples.

It would have been obvious to one skilled in the art at the time of invention to further utilize silica and/or calcium carbonate having the instant BET surface area (lower BET surface area) of Smith or Fiedler in Jada, Jacob et al and Miyahara et al thereof with or without silica since Jada teaches employing various fillers and since the use of mixed fillers in impression materials is well known as taught by Fiedler and since Smith and Fiedler teach employing advantage of employing low surface area (and thus low oil absorption) fillers, and further to to utilize said sterilized polydimethylsiloxane dental impression material containing radio-opacifying fillers in taking an impression of Porter et al since Porter et al teach taking an impression after implanting and since use of art well known impression taking material such as polydimethylsiloxane with known additives and sterilization would be a *prima facie* obviousness absent showing otherwise.

Claims 14-24 are rejected under 35 U.S.C. 103(a) as obvious over Porter et al (US 2003/0036036 A1) and Bublewitz et al (US 6,313,190), and in view of Jacob et al (US 6,342,187) and Miyahara et al (US 5,106,301).

Bublewitz et al teach two-component system in examples 1-6 wherein the instant polydimethylsiloxane having terminal vinyl groups in said each component and

viscosities and filler are taught. Also, polymethylhydrogensiloxane containing SiH groups meets the reticulating agent (col. 6, lines 36-51).

The instant invention recites employing radio-opacifying fillers and other fillers over Bublewitz et al, but, Bublewitz et al teach such modification at col. 3, lines 48, 49 and 61 and at cols. 5 and 6. Fillers having BET surface area of at least $50 \text{ m}^2/\text{g}$ are taught at col. 5, lines 23-28 and such filler would be substantially same as the instant fillers having a BET surface area below $50 \text{ m}^2/\text{g}$ since said below 50 could be 49.99, for example.

The instant invention further recites aseptic material and other radio-opacifying fillers over Bublewitz et al. However, sterilization of devices and materials used in dental and medical practices by various methods such as X-ray is well known practice as taught by Jacob et al, col. 2. Miyahara et al teach various radio-opacifying fillers at col. 3, line 58 to col. 4, line 9.

The instant invention now recites a method of impression taking during immediate loading technique over Bublewitz et al, Jacob et al and Miyahara et al who, in combination, teach the instant impression taking materials. However, said method of impression taking during immediate loading technique is well known practice in the art as taught by Porter et al, abstract and pp. [0037]-[0038]. A patient's mouth under immediate loading technique inherently has an open wound.

It would have been obvious to one skilled in the art at the time of invention to utilize radio-opacifying fillers and other fillers having the instant BET surface area in Bublewitz et al with sterilization by X-ray taught by Jacob et al before use since

Bublewitz et al teach employing radio-opacifying fillers and other fillers and since the BET surface area of Bublewitz et al is substantially same as the instant fillers having a BET surface area below 50 m²/g and since sterilization of devices and materials used in dental and medical practices by various methods such as X-ray in order to prevent any infection to patients is well known practice, and further to utilize other radio-opacifying fillers of Miyahara et al in Bublewitz et al thereof since Bublewitz et al teaching employing radio-opacifying fillers, and further to utilize said sterilized polydimethylsiloxane dental impression material containing radio-opacifying fillers in taking an impression of Porter et al since Porter et al teach taking an impression after implanting and since use of art well known impression taking material such as polydimethylsiloxane with known additives and sterilization would be a *prima facie* obviousness absent showing otherwise.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Tae H Yoon
Primary Examiner
Art Unit 1796